

CLAIMS OF THE INSTANT APPLICATION

Claims 1 - 12 are directed to a telescoping mast payload assembly for reducing the retracted height of a mast payload assembly including a fixed bottom section, a plurality of nonpayload carrying intermediate mast sections and a payload section for carrying a payload which can be at least partially received and protected within the nonpayload carrying intermediate support sections when a mast assembly is retracted. Meanwhile, Claims 13 - 17 are directed to a telescoping mast assembly for providing protection to a payload when the mast payload assembly is retracted including a fixed bottom section, a nonpayload carrying intermediate mast section, a payload section for carrying a payload and an attachment means for attaching the bottom section of the mast assembly to a vehicle.

The claims of the instant application are substantially identical to claims that were submitted to the Patent Office in an Office Action dated December 15, 1999 in the course of prosecuting reissue application Serial No. 09/283,843 (hereinafter "the '843 application"). The only difference between the claims of the instant application and those submitted in the amendment of December 15, 1999 is that the present claims include the language clarifying that the intermediate mast sections are "nonpayload carrying".

In response to Applicant's amendment, the Patent Office Examiner issued an Office Action dated January 21, 2000 withdrawing prior rejections based upon prior art, but this time rejecting the claims under 35 U.S.C. § 251 as being an improper recapture of claimed

subject matter deliberately cancelled in a parent application, citing *Ball Corp. v. U.S.*, 221 U.S.P.Q. 289, 295 (Fed.Cir. 1984). Though it was believed that this rejection was improper, to overcome this rejection, Applicant amended the claims to overcome the rejection under 35 U.S.C. § 251 with traverse, explicitly reserving the right to file a continuation application. In response, the claims of the reissue application were allowed and a reissue patent is expected to soon issue.

RECAPTURE RULE

The claims of the present application are not barred by the Recapture Rule. As correctly stated by the Examiner, the Recapture Rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application. See *Ball Corp. v. U.S.* Accordingly, the Recapture Rule requires a comparison of the instant claims to the cancelled claims of the original application. The claim from the original application that was cancelled during prosecution is set forth as follows.

1. An integrated telescoping mast-payload assembly comprising:
 - (a) at least two nesting, telescoping mast sections having upper and lower ends,
 - (i) a lower section

- (ii) a top section, dimensioned to slidably nest within said lower section,
- (b) means for extending and retracting said top section relative to said lower section from a fully retracted position to a fully extended position,
- (c) a payload forming the upper end of said top section, at least a portion of said payload being received within said lower section when said top section is fully retracted.

During prosecution of the earlier application, the Examiner correctly recognized that though the claim indicated that the payload forms part of the top section of the mast assembly, with at least a portion of the payload being received within the lower mast section when retracted, the claim did not properly exclude mast assemblies where the payload comprised not only the uppermost section, but were also carried in the lower immediate sections or in the bottom section of the mast assembly. Thus, the claim would read on mast assemblies such as telescoping automobile radio antennas. Recognizing that the invention was directed to a payload forming a mast section being protected by nonpayload carrying intermediate mast sections, Applicant amended the claim to define a mast assembly wherein the payload was located only in the mast assembly's uppermost mast section. The allowed independent claim is set forth as follows.

1. In a telescoping mast assembly, including:

a plurality of nesting, telescoping mast sections, including a top section and at least one lower section, each of said sections having upper and lower ends, and

means for extending and retracting each of said sections relative to the next-lower section,

the improvement comprising:

a payload, located only in said top section,

said top section, including said payload, being dimensioned to be received and nest within the next-lower section,

at least a portion of said payload being received within said next-lower section when said top section is fully retracted,

such that said next-lower section provides protection for

said payload when said top section is fully retracted,

said payload being a member of the group consisting of radio antennas, lights, instrumentation and telemetry packages for robotic vehicles, television cameras, antenna rotators, preamplifiers, radiation sensors and electronic and electro-mechanical instrument packages. (Claim 1 of U.S. Patent No. 5,615,855)

A review of the claims of the instant application, the cancelled claims of the original application and the allowed claims of U.S. Patent No. 5,615,855 demonstrates that the cancelled claim, by far, is of the broadest scope, covering any telescoping mast assembly wherein a payload is located in the top section of the assembly, but also including constructions where the payload is in a bottom section, or in an intermediate section. The only independent claim of the '855 patent is significantly narrower than the cancelled claim as it covers only telescoping mast assemblies wherein the payload is located only in the top section of the mast assembly. Finally, the claims of the instant application are significantly narrower than the cancelled claim as they include the limitations that the telescoping mast assembly include a plurality of nonpayload carrying intermediate sections (Claims 1 - 12), or the telescoping mast assembly includes at least one nonpayload carrying intermediate section for protecting the payload section and an attachment means for attaching the telescoping mast assembly to a vehicle (Claims 13 - 17). Admittedly, the claims of the instant application are broader than the claims of the '855 patent in one aspect as they

are not limited to the payload being located only in the top section of the mast assembly.¹

Accordingly, the scope of the cancelled claims, claims of the '855 patent and claims of the present application can be graphically depicted as follows.

|-----scope of cancelled claims-----|

|-----scope of claims in '855 patent -----|

|-----scope of claims in present application-----|

Now turning back to the Recapture Rule, the Recapture Rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application. *Ball Corp. v. U.S.*, 221, U.S.P.Q. § 289, 295 (Fed.Cir. 1984). However, the claims of the present application are clearly narrower in all aspects, not broader or of the same scope, than the cancelled claims.

As also stated in *Ball Corp. v. U.S.*, the recapture prohibition is presumptively avoided as to claims that are, as to the cancelled claims, narrower in some respect and broader only in respect that are not pertinent to the alleged error. Here, the claims are

¹ The claims of the present application may be permissibly broader in scope than the '855 patent as the application stems from a reissue application filed within two (2) years of the issue date of the '855 patent. See 35 U.S.C. § 251.

narrower with respect to the cancelled claims, which permitted the payload to be located in any of the mast sections, and not broader in any other respect. Thus, the Recapture Rule is presumptively avoided.

Also, as more recently stated in *In Re Clement*, 131 F.3d 1464, 45 U.S.P.Q.2d 1161 (Fed.Cir. 1997), the following principles flow: (1) if the reissue claim is as broad or broader than the cancelled or amended claim in all respects, the Recapture Rule bars the claim; (2) if it is narrower in all aspects, the Recapture Rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, than: (a) if the reissue claim is as broad or broader as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the Recapture Rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the Recapture Rule does not bar the claim, but other objections are possible.

In the present instance, the claims of the present application are narrower in all aspects, and thus under principal No. 2, the Recapture Rule does not apply. Even if it could be argued that the present claims were broader in an aspect than the cancelled claim, it has certainly been narrowed in an aspect germane to the prior art rejection. In particular, the cancelled claim covered mast assemblies wherein the payload was carried in any of the